

**REMARKS**

The Final Office Action mailed November 12, 2008 notes that claims 1-3, 7 and 12-25 are pending and rejects claims 1-3, 7, and 12-25. Claims 1, 7, 12-20, and 23 are amended. No claims are cancelled. New claim 26 is added. In view of the foregoing claims 1-3, 7 and 12-26 remain pending for which reconsideration is requested. No new matter is believed to have been added.

**Response to Examiner's Response to Arguments**

In the Office Action, on pages 5-7, the Examiner asserts that "[t]he Applicant fails to map the supported document of Exhibit B to each and every limitation in the invention claims." The Examiner also asserts that "[t]he evidence submitted is insufficient to establish diligence from the 3/9/1995 (concept of invention) to the filing date of this instant applicant: The applicant fails to provide support for diligence between 3/9/95 and 5/5/95, where evidence of record show no activity within this time gap." The above assertions are traversed with an argument below.

Exhibit B does support each and every element of the claims 1-3, 7, and 12-25. As asserted by the Inventor in Declaration, as seen on page 1 of Attachment B, text file IP~ along with fig2.gif and fig3.gif show a modified date of 3/28/1995. Pages 20-24 of Attachment B show the Inventor's Proposal with figures embedded which was submitted to management for review. Other documents found in Attachment B are drafts of the Invention Summary saved as different file types such as IP~.html last modified on March 28, 1995, as can be seen on page 1 of Attachment B. This document in Attachment B includes hypertext for viewing in a web browser. The following graph shows where each element of claim, for example, is supported in Attachment B.

	Where Support Can Be Found in Attachment B
A menu selection system, comprising: a display displaying a menu comprising a radial marking menu portion simultaneously displayed with a linear menu portion;	See page 20, brief summary of the invention: "We propose an invention which combines marking menus and linear menus in the same display such that the number of items can be increased beyond eight items." See page 20-21, paragraph beginning on the final line discussing "screen" which maps to "a display." See also page 22, Figure 2 depicting a radial

	marking menu portion simultaneously displayed with a linear menu portion.
a pointing device for indicating a type of selection by one of making a stroke having a direction and designating a location;	See page 20-21, paragraph beginning on final line of page 20. "A user presses down on the screen with the pen and waits for a short interval of time (approximately 1/3 second). A radial menu then appears directly under the tip of the pen. A user then highlights an item by keeping the pen pressed and making a stroke towards the desired item." See also example in Figure 1(a)."
and a computer connected to said display and said pointing device, and determining selection criteria for the type and a menu item selection based on a method of selection from the one of the stroke and the location.	For " <b>and a computer</b> connected to said display and said pointing device," see Introduction, second paragraph, on page 20: "Hot keys are also not effective if a user is working on <b>keyboardless system</b> or the user must move between the device and <b>another device</b> while operating the interface." There are also numerous references to "mouse." See page 21, paragraph beginning on last line of page 20. " <b>and determining...</b> If the item has no sub-menu, the item can be selected by lifting the pen. If the item does have a sub-menu, it is displayed. The user then continues, selecting from the newly displayed sub-menu...Lifting the pen will cause the current series of highlighted items to be selected."

Thus, it is submitted that the documents in Attachment B support each and every limitation of the claims is supported.

With respect to diligence of the Inventor, as is indicated in the Declaration, in item 2, the Inventor states that conception occurs "prior to March 9, 1995" and was documented "[o]n or

about March 9, 1995 in the hardbound notebook. Photocopies of the hardbound notebook are found in Exhibit A. Further, as discussed above, the Inventor indicates in item 3 of the Declaration that an invention proposal was prepared on March 22, 1995 and revised on March 28, 1995 and "forwarded to management to review and approve the invention for patenting." It is submitted that as of at least March 28, 1995, the invention was actively reduced to practice.

For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. (MPEP 2138.05, See, e.g., *Scott v. Finney*, 34 F.3d 1058, 1062, 32 USPQ2d 1115, 1118-19 (Fed. Cir. 1994). MPEP 2138.05 also states that "[t]he invention must be recognized and appreciated for a reduction to practice to occur." Page 24 of Attachment B clearly indicates that the Inventor built the invention and tested it, and appreciated that the invention was intended to be used in a future product. The Inventor was confident enough that the invention worked to forward the Invention Proposal of March 28, 1995 to management for review. Thus, the invention was actively reduced to practice before the filing date of Smith (April 28, 1995). Consequently, the Examiner's assertion with respect to "reasonable diligence" in MPEP 2138.06 and 35 U.S.C. § 102(g)(2) is misplaced as the Applicant both conceived and actively reduced to the invention to practice before the filing date of Smith. "Reasonable diligence" is only applicable for an Inventor who conceives an invention first and reduces the invention to practice second. Thus, Smith, having a filing date of April 28, 1995, is not a valid reference.

#### **Rejection under 35 U.S.C. § 102(e)**

In the Office Action, on page 2, claims 1-3, 7, and 12-25 are rejected under 35 U.S.C. § 102(e) as being anticipated by Smith (US 5,721,853). Although Smith is not valid as prior art as discussed above, this rejection is also respectfully traversed below.

Smith discusses a spot graphic element that has four radial quadrants representing different categories. When a mouse moves into one of the quadrants, a secondary hierarchical lineal menu is automatically displayed. The secondary lineal menu may be locked open so that it will not close when the mouse is moved out of the area. Each quadrant in Smith is always associated with a hierarchical secondary lineal menu and when a quadrant is selected, a secondary lineal menu opens for selection from (See Smith, Abstract; Figure 3E; Figure 7).

It is submitted that nothing cited or found in Smith discloses "a selection from the menu may be made without displaying the menu." Smith is entirely silent regarding this feature

because according to Smith, "the spot interface is sufficiently small that it may lie unobtrusively over any open window such that it is always on top." This feature implicitly indicates that a selection may not be made from the menu unless it is displayed and is "on top" of other windows or GUI objects. When a mouse pointer is moved into one of the quadrants of the collar, a secondary interface is displayed to select from. A keyboard may also be used to interact with the spot interface by pressing the alt-tab keys or a hotkey, which displays the collar. (See Smith, Figure 5, 502, column 2, lines 55-60, column 3, lines 2-7 and 43-50, column 7, lines 8-25). Smith's failure to disclose this feature is further strengthened by 702, "Display Spot GDE," in Figure 7 of Smith, the first step of implementing the spot interface. Thus, one may not make a selection from the spot interface unless it is displayed.

Additionally, it is respectfully submitted that nothing cited in the Office Action or found in Smith discloses "a display **displaying a menu comprising a radial marking menu portion** simultaneously displayed with a linear menu portion" as recited in claim 1. Smith merely discusses a radial menu, not "a radial **marking menu portion**." While Smith's radial quadrants depicted in Figure 3D of Smith are selected merely by moving a pointer into the quadrant, the marking menu portion of claim 1 is selected by moving a cursor in the direction of the marking menu portion while selecting the marking menu portion, for example, by depressing a mouse button. As Smith notes in column 3, lines 2-4, "[w]hen the mouse pointer is subsequently moved into any one of the four quadrants in the color, a secondary interface associated with that quadrant is displayed." Thus Smith is entirely unrelated to a marking menu portion.

Withdrawal of the rejection is requested.

Independent claims 7, 12-17, 20, and 23 are amended to clarify patentably distinguishing features in a similar manner to claim 1 and thus are also not disclosed by Smith.

Independent claims 18 and 19 are amended to clarify patentably distinguishing features which are not disclosed by Smith. In particular, claim 18 and 19 recite "the radial marking menu portion represents a grouping of menu items based upon frequency of selection." Smith is silent regarding "the radial marking menu portion" which contains "menu items based upon frequency of selection."

The dependent claims depend from the above-discussed independent claims and are patentable over Smith for at least the reasons discussed above.

**New Claim 26**

New claim 26 recites patentably distinguishing features which are not disclosed by Smith. In particular, claim 26 recites "selectable items in the radial marking menu sub-menu are included based on a priority" and "the selection can be made when the menu is not visible which are not disclosed by Smith." In light of the above discussion, Smith is silent regarding selectable items based on a priority such as frequency of selection and selection of an item even if the menu is not displayed. Thus claim 26 is patentable over Smith.

**Conclusion**

It is submitted that the claims are not taught, disclosed or suggested by the prior art. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,

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